

REMARKS

Applicants respectfully request reconsideration of the instant application in light of the forgoing amendments and the following remarks. By this Response, Applicants have added new claim 35 and amended claim 12 to correct a minor typographical error. Applicants submit that support for the new and amended claims may be found throughout the originally filed specification, drawings, and claims and that no new matter has been added by way of this Response. Claims 1-35 are currently pending in the application.

Rejection Under 35 USC § 103(a)

The Examiner has rejected claims 1, 2, 16 and 21 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Cwenar (US 5,893,079; hereinafter, "Cwenar") in view of Rhonda Bissig ("Merrill, ex-broker hit with multi-million dollar lawsuit in N.H.," Rhonda Bissig, Wall Street Letter, New York: Feb. 7, 2000, Vol. 32, Iss. 6, pp. 1-2; hereinafter, "Bissig"). The Examiner has also rejected claims 3-15, 17-20 and 22-34 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Cwenar in view of Bissig and in further view of alleged "Applicant's Admitted Prior Art (APA)". Applicants respectfully traverse the Examiner's rejection and submit that a prima facie case of obviousness has not been established and that the pending claims are patentably distinct from the cited references, taken alone or in combination, for at least the following reasons.

MPEP § 706.02(j) prescribes that a rejection under 35 U.S.C. § 103 should set forth:

- (i) the relevant teachings of the prior art relied upon,
- (ii) the differences in the claim over the applied references,
- (iii) the proposed modification of the applied references to arrive at the claimed subject matter, and

- (iv) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made.

Applicants submit that the rejections in the pending Office Action do not establish each of these requirements.

Applicants submit that the rejections in the May 9, 2008 Office Action fail to establish the relevant teachings of the prior art relied upon and differences in the claim over the applied references by not addressing every claim limitation and by over-generalizing references. The MPEP prescribes that, "when evaluating the scope of a claim, *every limitation in the claim must be considered*," [§ 2106 II(C), emphasis added] and, "*All words* in a claim must be considered in judging the patentability of that claim against the prior art." [§ 2143.03, emphasis added].

Applicants submit that the pending rejection has cited no reference nor taken Official Notice with respect to several elements of the pending claims. By way of example only, Applicants note that the pending rejection has not addressed the claim element, "generating a compliance rule set identifying at least one compliance rule in the collection of compliance rules by combining a baseline rule set and at least one additional rule set selected in accordance with the party profile," as recited in independent claim 16. In another example, the pending rejection has failed to address, "a list server having access to data indicating financial instruments subject to restrictions and configured to receive a query indicating a particular instrument and return data indicating restrictions associated with the particular instrument," and, "a profile database storing profile information for a plurality of parties, profiles reflecting at least the relationship between each respective party and the entity," as recited in independent claim 21. Instead of addressing the explicit language recited in the claims, the pending rejection has maintained that, "claims 16 and 21 are rejected with the same rational & analysis as claim 1," (May 9, 2008 Office Action, p.

4, ¶ 1) despite the different scope and different and/or additional claim elements recited in those claims as compared to claim 1. Accordingly, Applicants respectfully request reconsideration and withdrawal of the pending rejection. Should the Examiner disagree, Applicants respectfully request that the Examiner address the claim elements as recited and fully consider "[a]ll words in a claim" in judging the patentability of each and every claim against the prior art, as required by MPEP § 2143.03.

Further, Applicants submit that the pending rejections are based on over-generalized applications of the cited references. By way of example only, Applicants note that the Office Action recites, "(c) accessing a compliance rule set identifying at least one compliance rule selected in accordance with a profile associated with the party [col. 10 lines 23-35 - 'rules have been established with respect to a specific user']." (May 9, 2008 Office Action, pp. 2-3, ¶ 3). The cited portion of Cwenar discusses, "user interface means . . . [that] permit users to access the central database . . . [and] all data permitted within whatever rules have been established with respect to a specific user." (Cwenar, col. 10, lines 26-30). Applicants have previously noted the clear fact that the "rules" described in the cited portion of Cwenar are database access rules and not compliance rules. (See, e.g., January 9, 2009 Office Action, p. 12, ¶ 1). In response, the pending rejection states,

In addition to column 10, also, see the functions and architecture of Cwenar's system through out the disclosure [for example, col. 2 line 65 to col. 3 line 2; Figure 5 and corresponding description]. It is obvious that the compliance are compared with data/rules stored on the database and the party is the "user", "he" or "she" and the one compliance "prohibited from purchasing a certain category of stocks", and compliance rule set "first group of rules". (May 9, 2008 Office Action, p. 10, ¶ 2; original emphasis)

Applicants do not understand the maintaining of the citation to column 10 of Cwenar and respectfully request clarification as to how the Examiner believes the database

access rules described at col. 10, lines 26-30 are somehow analogous to a "compliance rule" as recited in the claims. Furthermore, Applicants submit that the mere mention of rule-based compliance, a group of rules, and/or a user does not anticipate or render obvious "accessing a compliance rule set identifying at least one compliance rule selected in accordance with a profile associated with the party, the profile reflecting at least the relationship between the party and the entity," as recited in independent claim 1. Nowhere in the cited references is there any discussion of "accessing a compliance rule set identifying at least one compliance rule selected in accordance with a profile associated with the party, the profile reflecting at least the relationship between the party and the entity." In fact, Applicants submit that there is no discussion of user profiles at all in Cwenar, making it impossible for Cwenar to anticipate or render obvious "at least one compliance rule selected in accordance with a profile associated with the party," as recited in claim 1. As none of the references, taken alone or in combination, teach or render obvious at least this claim element, Applicants respectfully request reconsideration and withdrawal of the rejection. Should the Examiner disagree, Applicants respectfully request that the Examiner *specifically* indicate where the cited references discuss the claim element, taken as a whole, as required, *inter alia*, by MPEP § 2106 (II)(C) and 2141.02(I).

Furthermore, Applicants submit that the rejections in the May 9, 2008 Office Action have not established why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made by not treating the claims as wholes, by not discussing the level of ordinary skill in the art at the time of the invention, and by applying impermissible hindsight.

MPEP § 2141.02 (I) states, "In determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves

would have been obvious, but whether the claimed invention as a whole would have been obvious." [See, MPEP § 2141.02(I); original emphasis]. MPEP § 2106 (II)(C), states *inter alia*: "USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered." Applicants submit that the pending rejection concludes obviousness of the alleged differences of the claim elements over the cited art in isolation and not in respect to the claim elements recited in each claim taken as a whole. By way of example only, Applicants note that the pending rejection alleges, "(c) accessing a compliance rule set identifying at least one compliance rule selected in accordance with a profile associated with the party [col. 10 lines 23-35 - ' rules have been established with respect to a specific user']," (May 9, 2008 Office Action, pp. 2-3, ¶ 3) but goes on to say, "Cwenar does not explicitly disclose the profile reflecting at least the relationship between the party and the entity. . . . [but] Bissig discloses this feature." (May 9, 2008 Office Action, pp. 3, ¶ 1). Applicants submit that the pending rejection has precisely dissected the claim element and evaluated obviousness of the resulting pieces in isolation. In another example, the rejection alleges,

Further, database administration, account setup, logging into database, accessing database, access privileges to database and tables based on severity level, groups, category etc are old and will known. Where these access privileges are set based on the business choices, interaction with public, management practices, etc. . . . It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Cwenar, Bissig, and APA and include different set of database access privileges for database users to provide users with the information they are allow to know and at the same time to protect the business confidential information to reach unauthorized users who not suppose to have access to them. (May 9, 2008 Office Action, pp. 6-7, ¶ 2)

Evidently, the pending rejection has dissected and reworded the claim language, and has not even cited a reference nor taken Official Notice with respect to the resulting elements, instead making a conclusory assertion that the isolated elements in are old and well

known. Applicants traverse this argument and submit that, by dissecting the claim into discrete elements, rephrasing the elements, and evaluating the rephrased elements in isolation, without reference to the claim as a whole or specifying the pertinent art or the level of ordinary skill relevant thereto, impermissible hindsight has been applied in alleging obviousness of the claims. Accordingly, Applicants request reconsideration and withdrawal of this basis of the rejection. Should the Examiner disagree, Applicants respectfully request that the Examiner provide evidence to support the rejection by either citing a reference or taking Official Notice. Furthermore, Applicants respectfully request that the Examiner adhere to the actual language used in the claims, refrain from dissecting claim elements, and address obviousness of the *claims and their limitations as wholes* as required, *inter alia*, by MPEP § 2106 (II)(C) and 2141.02(I).

Applicants further submit that the pending rejection fails to provide a proper explanation of why the claims would have been obvious to one of ordinary skill in the art at the time of the invention by not providing an indication of the level of ordinary skill. MPEP § 2141 (II)(C) states, "Any obviousness rejection should include, either explicitly or implicitly in view of the prior art applied, an indication of the level of ordinary skill." The pending rejection repeatedly refers to, "one of ordinary skill in the art," but has provided no indication, explicit or otherwise, of what art is being referred to or the level of ordinary skill that the Examiner believes is associated therewith. Nor do the applied references provide any indication of the level of ordinary skill, as those references are disparate in scope and subject matter: Cwenar is a patent directed to a "computerized data processing system" for "processing [investment] data ... and stor[ing] such investment data in a central database" (Cwenar, abstract), while Bissig is a news article describing a lawsuit against a securities broker for "fraud and deceit, unauthorized transactions, breach of fiduciary duty and churning" (Bissig, p. 1, ¶ 1). Furthermore, the pending

rejection has made repeated reference to other alleged prior art (e.g., "Oracle8i Certified Professional DBA Certification Exam Guide" [May 9, 2008 Office Action, p. 12, ¶ 2], APA [May 9, 2008 Office Action, p. 4, ¶ 2-3]) that further obfuscate the art in question and the "level of ordinary skill" associated therewith. MPEP § 2141.03 (III) states, "The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry." Applicants submit that impermissible hindsight has been applied in asserting obviousness of the various claim elements without providing an indication of the level of ordinary skill. As such, Applicants respectfully request that, if the Examiner maintains this rejection, the Examiner discuss the level of ordinary skill in the art at the time of the invention and clarify how the claimed subject matter would have been obvious to one possessing that level of skill.

Applicants also submit that the pending rejection has applied impermissible hindsight in formulating explanations as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made. By way of example only, Applicants point to the argument at p. 7, ¶ 2 of the May 9, 2008 Office Action, where the Examiner states:

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Cwenar, Bissig, and APA and include different sets of database access privileges for database users to provide users with the information they are allowed to know and at the same time protect the business confidential information to reach unauthorized users who not supposed to have access to them.

Though the rejection provides a description of an alleged advantage of the described combination of elements, it includes no explanation as to why the alleged advantage would have been evident to one of ordinary skill at the time of the invention. Furthermore, Applicants submit that the rejection's discussion of "database access privileges for database

users" includes no discernible relation or nexus to any of the claim elements that are allegedly rendered obvious by this argument, such as, by way of example only, "restrictions in the first list having an associated severity level," as recited in claim 4 or "extracting the company name from the document and mapping the extracted company name to an associated instrument," as recited in claim 14. Accordingly, Applicants submit that the rejection has applied impermissible hindsight and reconstruction of the claims and respectfully request reconsideration and withdrawal of this basis of the Examiner's rejection. Should the Examiner disagree, Applicants respectfully request clarification as to how the described combination would have been evident to one of ordinary skill at the time of the invention based on verifiable evidence predating Applicants' invention.

For at least the reasons discussed above, Applicants submit that the pending rejection has not established a prima facie case of obviousness, and that independent claims 1, 16, and 21, as well as new claim 35, are patentably distinct from the cited references, taken alone or in combination. Furthermore, dependent claims 3-15, 17-20 and 22-34, which depend from independent claim 1, 16 and 21 respectively, are patentably distinct from the cited references, taken alone or in combination, for at least similar reasons. Accordingly, Applicants respectfully request reconsideration and withdrawal of the Examiner's rejection for all pending claims.

CONCLUSION

Consequently, the reference(s) cited and/or any official notice taken by the office action do not result in the claimed invention, there was/is no motivation for such a combination of references (i.e., cited references do not teach, read on, suggest, or result in the claimed invention(s)), and the claimed inventions are not admitted to be prior art. Thus, the Applicant

respectfully submits that the supporting remarks and claimed inventions, claims 1-35, all: overcome all rejections and/or objections as noted in the office action, are patentable over and discriminated from the cited reference(s), and are in a condition for allowance. Furthermore, Applicant believes that the above remarks, which distinguish the claims over the cited reference(s), pertained only to noted claim element portions. These remarks are believed to be sufficient to overcome the prior art. While many other claim elements were not discussed, Applicant does not concede that any such elements are found in the prior art and/or within any official notice taken in the office action, and as such, Applicant asserts that all such remaining and not discussed claim elements, all, also are distinguished over the prior art, including any official notice taken in the office action, and explicitly reserves the opportunity to more particularly remark and distinguish such remaining claim elements at a later time should it become necessary. Further, any remarks that were made in response to an Examiner objection and/or rejection as to any one claim element, and which may have been re-asserted as applying to another Examiner objection and/or rejection as to any other claim element(s), any such re-assertion of remarks is not meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claim elements, and no such commonality is admitted as a consequence of any such re-assertion of remarks. As such, Applicant does not concede that any claim elements have been anticipated and/or rendered obvious by any of the cited reference(s). Accordingly, applicant respectfully requests allowance, and the reconsideration and withdrawal of the rejection(s) and/or objection(s).

If a telephone conference would facilitate prosecution of this application in any way, the Examiner is invited to contact the undersigned at the number provided.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. 03-1240, Order No. 17209-019.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 03-1240, Order No. 17209-019

Respectfully submitted,
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